<center>**REMARKS**</center>

In the present response, claims 1, 5, and 6 have been amended, claims 3 and 4 have been canceled, and claims 34-46 have been added. Claims 1, 5-12, and 34-46 remain pending in the captioned case. Further examination and reconsideration of the presently claimed application are respectfully requested.

Allowable Subject Matter

Claims 3-6 were objected to for being dependent on a rejected base claim, but would be allowable, if rewritten to include all limitations of the base claim and any intervening claims. As set forth herein, all limitations of claims 3 and 4 have been incorporated into base claim 1. Accordingly, Applicants assert that independent claim 1 and all claims dependent therefrom are now in condition for allowance.

Section 103 Rejections

Claims 1 and 7-12 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,678,719 to Stimmel (hereinafter "Stimmel") in view of U.S. Patent No. 5,801,700 to Ferguson (hereinafter "Ferguson"). In light of the amendments to claim 1 which incorporate the allowable subject matter of claims 3 and 4, Applicants believe this rejection has been obviated in its entirety. Accordingly, Applicants respectfully request removal of this rejection.

Patentability of Added Claims

Claims 34-46 have been added in the present response to recapture subject matter previously canceled. Support for the addition of claims 34-46 may be found in originally filed claims 13-29. As such, the addition of claims 34-46 does not introduce new matter. As set forth in more detail below, independent claims 34 (a system) and 41 (a computer-usable carrier medium) include limitations similar to the allowable subject matter recited in claims 3-6.

The cited art fails to provide teaching, suggestion or motivation for a system or carrier medium comprising means (e.g., program instructions) for receiving notification of a desired participant in a communications session and a desired communications application for use in the communications session, wherein said receiving comprises: detecting selection of a first icon representing the desired additional participant, and detecting movement of the first icon to a position of a second icon representing the desired communications application. Amended independent claim 34 recites in part:

> A system for computer-based communications, comprising: means for displaying, on a display screen of the computer, a graphical user interface including representations of multiple communications applications accessible using the computer and of multiple potential participants in a communications session, wherein said representations comprise icons; means for receiving, from a user of a computer, notification of a desired participant in a communications session and a desired communications application for use in the communications session, wherein the desired communications application is selected from the multiple communications applications accessible using the computer, and wherein said notification comprises detecting a combined selection of a first icon representing the desired communications application and a second icon representing the desired participant…

Independent claim 41 recites in part:

> A computer-usable carrier medium, comprising: first program instructions executable on a computer for displaying, on a display screen of the computer, a graphical user interface including representations of multiple communications applications accessible with the computer and of multiple potential participants available for a communications session, wherein said representations comprise icons; second program instructions executable on the computer for receiving, from a first participant, notification of a desired additional participant in a current communications session and a desired communications application for use in the current session, wherein the desired communications application is currently selected, or has been previously selected, from the multiple communications applications, and wherein said receiving comprises: detecting selection of a first icon representing the desired additional participant; and detecting movement of the first icon to a position of a second icon representing the desired communications application…

Claims 34 and 41 each include limitations on receiving notification of a desired participant <u>and</u> a desired communications application by detecting selection of a first icon and a second icon. In claim 34, the first icon represents the desired communications application and the second icon represents the desired participant (the opposite is true in claim 41). In claim 34, notification also includes detecting movement of the first icon to a position of the second icon (i.e., dragging and dropping the first icon onto the second icon).

Statements in the Office Action admit that "Stimmel fails to explicitly disclose detecting selection of <u>an icon</u> within a graphical user interface," but suggest that Ferguson can be combined with Stimmel to overcome the deficiencies therein (see, Office Action, page 3). As described in more detail below, Ferguson and Stimmel cannot be combined in a manner that would provide teaching or suggestion for the presently claimed icons, or the manner in which the presently claimed icons may be used to establish a communications session between users, as recited in claims 34 and 41.

Stimmel discloses a virtual workplace intercommunication tool (Stimmel, tool). More specifically, Stimmel discloses a system including a plurality of communications devices, each of which is operable for displaying, to a user, the communications procedure(s) available for contacting the other users based on their status. For example, the communications procedures available for contacting the user John (whose status is "Available") may include email, telephone, facsimile, instant chat, and video conferencing, as shown in Fig. 3A. *See*, e.g., Stimmel, Abstract, Fig. 3 and associated text.

Unlike the presently claimed case, however, Stimmel does <u>not</u> teach or suggest that a user may receive notification of a desired participant (e.g., another user) and a desired communications application (e.g., a desired communications procedure for contacting the other user) by detecting selection of a first icon (representing, e.g., the desired communications procedure) and a second icon (representing, e.g., the other user), as recited in claims 34 and 41. Stimmel also fails to provide teaching or suggestion for detecting movement of the first icon to a position of the second icon, as further recited in claim 41. Stimmel simply fails to mention

icons, or the manner in which the presently claimed icons are used to establish a communications session between users.

Ferguson discloses a drag-and-drop graphical user interface for transferring files from a user to a recipient (Ferguson, Abstract). Although Ferguson discloses a system and method in which files are transferred by selecting an icon (representing, e.g., a file to be transferred) and then moving the icon to the position of another icon (representing, e.g., a recipient), <u>Ferguson cannot be combined with Stimmel</u> to overcome the deficiencies therein.

First of all, Ferguson fails to disclose the claimed subject matter, which is specifically lacking within Stimmel. For example, the only icons disclosed by Ferguson are (i) those representing files to be transferred, and (ii) those representing recipients (*See* Ferguson -- col. 1, lines 33-40). Ferguson fails to provide teaching or suggestion for including icons <u>representing multiple communications applications</u> available for use in a communications session. The only "communications application" disclosed by Ferguson for transferring the files from the user to the recipient is the file transfer protocol (*See* Ferguson -- col. 1, lines 47-55; col. 5, lines 9-53; Fig. 2). Ferguson fails to teach, suggest or even provide desirability for using other "communications applications" to transfer the files, and thus, fails to provide the necessary motivation that would enable one skilled in the art to modify the teachings of Ferguson to include icons representing multiple communications applications. For at least these reasons, Ferguson cannot be relied upon to provide teaching, suggestion or motivation for: (i) detecting a combined selection of a first icon representing a desired communications application and a second icon representing a desired participant (as recited in claim 34), or (ii) detecting selection of a first icon representing a desired additional participant, and detecting movement of the first icon to a position of a second icon representing a desired communications application (as recited in claim 41).

Since neither reference provides teaching, suggestion or motivation for the aforementioned limitations, the references <u>cannot be combined</u> in a manner to provide such teaching. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. *In re Fine*,

837 F.2d 1071, 5 USPQ2d 1596 (Fed.Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992), MPEP 2143.01.

In addition, Stimmel and Ferguson <u>cannot be modified</u> to provide teaching or suggestion for the above-mentioned limitations of claims 34 and 41, since neither reference suggests the desirability for such modification. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination [or modification]. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); MPEP 2143.01.

As noted above, Stimmel fails to provide teaching, suggestion or desirability for using icons to establish a communications session between users, and more specifically, for dragging and dropping a first icon (representing, e.g., a desired participant) onto a second icon (representing, e.g., a desired communications application to be used in the session). Although Ferguson provides a drag-and-drop file transfer interface, Ferguson fails to provide teaching, suggestion or desirability for possibly using other communications applications (other than file transfer protocol) for transferring files. Therefore, both references lack the necessary desirability that would enable one skilled in the art to modify the teachings of the cited art to provide the presently claimed system and carrier medium, in which notification of a desired participant <u>and</u> a desired communications application is received by (i) detecting a combined selection of a first icon representing a desired communications application and a second icon representing a desired participant (as recited in claim 34), or (ii) detecting selection of a first icon representing a desired additional participant, and detecting movement of the first icon to a position of a second icon representing a desired communications application (as recited in claim 41).

For at least the reasons set forth above, Stimmel and Ferguson each fail to provide teaching, suggestion or motivation for the aforementioned limitations of claims 34 and 41. In addition, the cited art references cannot combined or modified to disclose all limitations of present claims 34 and 41. As a result, claims 34, 41 and all claims dependent therefrom are patentably distinct over the cited art. Accordingly, approval of added claims 34-46 is respectfully requested.

CONCLUSION

The present amendment and response is believed to be a complete response to the issues raised in the Office Action mailed September 22, 2006. In view of the remarks and amendments herein, Applicants assert that pending claims 1, 5-12, and 34-46 are in condition for allowance. If the Examiner has any questions, comments or suggestions, the undersigned attorney earnestly requests a telephone conference.

No fees are required for filing this amendment; however, the Commissioner is authorized to charge any additional fees which may be required, or credit any overpayment, to International Business Machines deposit account number 09-0447.

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